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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,587	12/04/2001	Michael A. Tainsky	0788.00063	5172

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KOHN & ASSOCIATES PLLC
30500 NORTHWESTERN HWY
STE 410
FARMINGTON HILLS, MI 48334

EXAMINER	
CLOW, LORI A	
ART UNIT	**PAPER NUMBER**
1631	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/02/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/004,587	TAINSKY ET AL.	
	Examiner	Art Unit	
	Lori A. Clow, Ph.D.	1631	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 January 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *7 and 8* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *7 and 8* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicants' response, filed 16 January 2007, has been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Claims 7 and 8 are currently pending. Claims 1-6 and 9-19 have been cancelled.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sioud et al. (European Journal of Immunology (2001) Vol. 31, pages 716-725; recited previously), in view of WO 99/39210 (5 August 1999; Miller et al.).

The instant claims are drawn to a method of detecting and identifying a microarray of markers indicative of disease stage by differentially biopanning sera from normal and diseased patients and identifying epitope bearing clones present in the disease stage based upon antibody reactivity, thereby detecting an array of markers of disease.

In regard to claim 7, Sioud teaches the analysis of the humoral response in patients with cancer. Libraries from breast cancer cell lines were biopanned and positive clones were selected. Using serum antibodies from patients with breast cancer, IgG-binding phage-encoded cDNA products were selected and the clones identified important antigens including p53, pentraxin and others. The selected phage-displayed cDNA products were recognized by a significant number

of breast cancer sera as compared to normal individuals (abstract; Results and Discussion section 2.2 on page 717).

In regard to claim 8, a computer is utilized to quantitate densitometric imaging on an immunospot assay that was used to determine the presence or absence of antibodies against the selected phage-encoded cDNA products in normal and cancer patient sera. Thus, "identifying" results of the biopanning step (page 718, column 1, paragraph 1).

Sioud et al. do not specifically teach a "microarray" of markers within sera. However, Miller et al. teach a high-density protein array for proteome analysis (page 1, lines 5-21). The array may be for high throughput and can be constructed on microtitre wells, membrane support, silicon chips or grids (page 17, lines 1-13).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to have utilized the techniques of Sioud to biopan and select clones to array in a large format, as presented by Miller. One would have been motivated to do so because Miller teaches that primary arrays may be developed to emulate antigenic diversity of a cell, tissue, organ, organism from which a biological sample is derived (page 5, lines 16-19). The arrays may be used for comparative purposes to determine whether the protein profile of a "test sample" possess any differences in terms of expressed proteins to a biological reference (page 6, lines 15-16). Miller teaches the use of the arrays to diagnose a human or animal for a medical condition, ailment, illness, or immune response by comparing proteins detected in the biological sample with proteins in a standard, wherein the differences are indicative of the medical condition, ailment, illness, or immune response (page 11, lines 16-30).

Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sioud et al. (European Journal of Immunology (2001) Vol. 31, pages 716-725; recited previously), in view of 2003/0003516 (2 January 2003 with priority to 10 April 2001; Robinson et al.).

The instant claims are drawn to a method of detecting and identifying a microarray of markers indicative of disease stage by differentially biopanning sera from normal and diseased patients and identifying epitope bearing clones present in the disease stage based upon antibody reactivity, thereby detecting an array of markers of disease.

In regard to claim 7, Sioud teaches the analysis of the humoral response in patients with cancer. Libraries from breast cancer cell lines were biopanned and positive clones were selected. Using serum antibodies from patients with breast cancer, IgG-binding phage-encoded cDNA products were selected and the clones identified important antigens including p53, pentraxin and others. The selected phage-displayed cDNA products were recognized by a significant number of breast cancer sera as compared to normal individuals (abstract; Results and Discussion section 2.2 on page 717).

In regard to claim 8, a computer is utilized to quantitate densitometric imaging on an immunospot assay that was used to determine the presence or absence of antibodies against the selected phage-encoded cDNA products in normal and cancer patient sera. Thus, "identifying" results of the biopanning step (page 718, column 1, paragraph 1).

Sioud et al. do not specifically teach a "microarray" of markers within sera. However, Robinson et al. teach an epitope array for determining a specificity profile in a patient (page 2, paragraph 0009). The arrays are high density (page 2, paragraph 0016).

It would have been prima facie obvious to one of ordinary skill in the art at the time of the invention to have used the methods of Sioud with the high-density arrays of Robinson. One would have been motivated to do so because Robinson teaches the use of arrays or epitopes, for example, to screen for disease (page 6, paragraph 0047).

Note: Appliants arguments with regard to Sioud as a 102 reference have been considered and are persuasive in terms of Sioud not teaching a "microarray". It is also noted that Applicant states that the claims recite a "high throughput method". However, the claims do not specifically recite "high throughput" or "detecting sets of markers of disease".

No claims are allowed.

Inquiries

Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The Central Fax Center Number is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lori A. Clow, Ph.D., whose telephone number is (571) 272-0715. The examiner can normally be reached on Monday-Friday from 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Irem Yucel can be reached on (571) 272-0781.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete

service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

February 27, 2007
Lori A. Clow, Ph.D.
Art Unit 1631
Lori A. Clow
Patent Examiner
2/27/07